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Attorney of Record



PATENT

Dkt No. 180009.91206A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences**

Applicant: Jon R. Stieber et al. Art Unit: 3627
Appl. No.: 10/005,023 Examiner: E. Yun
Filed: December 4, 2001
For: AUTOMATIC CASH HANDLING MACHINE WITH WIRELESS
NETWORKED I/O DEVICES

APPELLANTS' REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants, Jon R. Stieber et al., having filed a timely Brief on Appeal in the above-identified patent application, hereby submit this brief in reply to the Examiner's Answer.

(10) REPLY TO EXAMINER'S RESPONSE TO ARGUMENT

With respect to Issue (A), the Examiner states that "there is no negative limitation in the claim (claim 1)" that would exclude the "system control unit" from being construed as the PDA of Waller. This is a "red herring" or diversionary argument.

This sets up a false requirement that does not exist in the law and diverts attention from the issue of how to construe the claim language for purposes of comparison with the prior

art. The Examiner's construction of the claim language has no basis in the specification, in the other claims or in the prior art.

The Examiner's construction of the term "system control unit" is merely a personal opinion and a matter of advocacy, which is based on an incomplete or incorrect reading of the specification and of the prior art reference being cited.

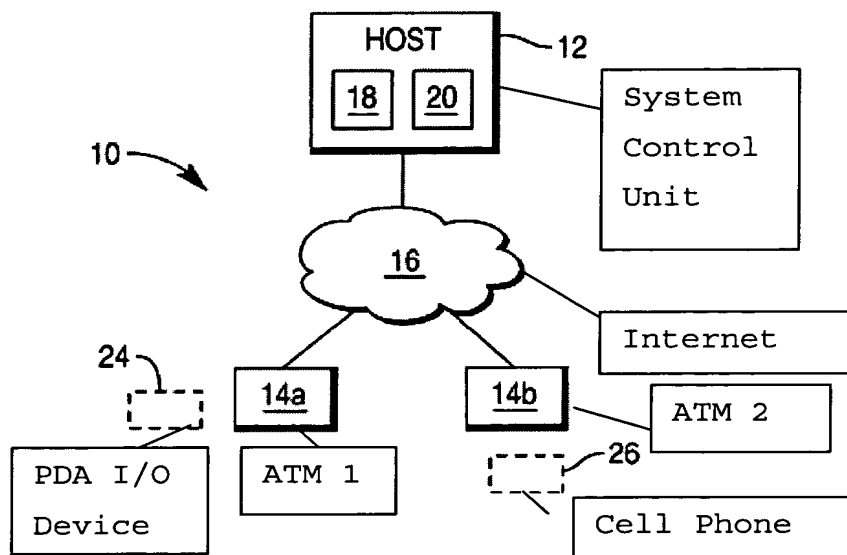
The Examiner's next statement goes further from the issues in this case in alleging that the Appellant has not pointed out the differences from the prior art. It is clear that if the claim language is construed as suggested by the Appellant that it distinguishes from the prior art for the same reasons.

Under the "broadest reasonable interpretation" rule governing interpretation of claims in the USPTO, the Examiner cannot adopt an interpretation of terms in the claims in a manner inconsistent with 1) the specification, 2) the other claims 3) the prior art or 4) the understanding of one of ordinary skill in the art. *In re Bond*, 910 F.2d 831, 833, 15 U.S.P.Q.2D (BNA) 1566, 1567 (Fed. Cir. 1990): ("It would be unreasonable for the PTO to ignore any interpretive guidance afforded by the Appellants' written description. The PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the Appellants' specification.")

The Examiner's next remark about 37 CFR 1.111(b) fails to recognize that if the claims are interpreted as Appellants' propose, that the language concerning the system control unit, and other language pointed out in the claims regarding the network interaction of the system control unit with the other machines of the cash management system, distinguishes from Waller.

There is no legal authority either cited by the Examiner or in existence, for the Examiner's position that a negative limitation must be included in the claims to constrain his interpretation.

The Examiner raises a new issue in the Answer that both a PDA 24 and cell phone 26 are disclosed in Fig. 1 in Waller. However, these communicate with different ATMs 14a and 14b in Fig. 1, which are only tied together through a long distance Internet network 16 and the host computer 12, so this is a further non-correspondence between the reference and the claims. (See Fig. 1 below from Waller.)



**Fig. 1 of Waller et al.
reference with annotations**

The Examiner has reduced the following claim language to "any computer":

a system control unit for performing at least one of a plurality of operations of accounting for cash dispensing by the cash handling device, providing for cash settlement of transactions carried out by the cash handling device and monitoring maintenance information, said control unit also providing commands to the cash handling device for operation of the cash handling device;

This does not merely describe any device having a microelectronic CPU, such as PDA or a cell phone.

Appellants' point is that the PDA may have a micro CPU, but it is functioning as a remote I/O keyboard or a remote control, and does not meet the full recitation of the system control unit of these claims for a wireless networked cash management system. It is clear that the system control unit in Waller is the host computer at the bank (See Fig. 1 above) and not the PDA 24.

In any event, the PDA is claimed in claim 5 as an I/O device, which is the nature of a remote keyboard or remote control device.

The Examiner's comment on Issue B is another misreading of the claim language. Accounting for cash dispensing is different from cash dispensing per se (which could be done by a vending machine or by an ATM which would then communicate with the host computer to do the accounting for the transaction.)

On Issue C, the Examiner's support for the rejection of claim 5 is limited to one sentence on page 6 and one sentence at the bottom of page 10. Both sentences are incorrect, when considered in the context of the rejection of claim 1, from which claim 5 depends.

With respect to the sentence in claim 5, this constitutes reading the pager or cell phone twice in the claim as a whole to meet two very different elements.

With respect to the comment on page 10, the Examiner has made another elementary mistake in claim reading. "Further comprising" does mean, according to the longstanding and well-known patent-legal interpretation, that the I/O devices are in addition to the system control unit. For the Examiner's understanding that the same claim element is being recited a second time, the claim would have had to read "wherein the system control unit further comprises" instead of how it reads now: "the cash management system further comprising."

The Examiner has also ignored the multiple dependent claim form of claim 5, so his action is procedurally deficient in that he has not considered all of the claims (See Section 5 and 6, Appeal Brief, pages 22-25). He has not considered the addition of claim 5 differently when depending from claims 2 or 3, than when depending from claim 1, which is the proper way to examine multiple dependent claims. It is respectfully requested, however, that the case not be remanded to correct this matter, as this is only a dependent claim and the final Office action should be reversed on claim 1, 2, 3 or 4, which would make a reversal on claim 5, a moot question.

With respect to Issue D, Appellants' remarks concerning the "back end" and "front end" were just a way of trying to orient the Examiner in comparing the block diagrams in the references to the block diagrams in the application and in trying to have the Examiner correctly trace the circuits connecting the blocks in the drawings.

Claim 1 recites "wherein said cash handling device and said system control unit communicate through a wireless communication network operating according to a standard for locally distributed wireless networks." (network 1)

Claim 6, which depends from claim 1 recites:

"wherein the system control unit is electrically connected to a second network selected from a group consisting of: the Internet, an intranet, a LAN and a WAN." (network 2)

The recitation of the second network signifies that it is different from the first-mentioned network operating according to a standard for locally distributed wireless networks in claim 1. If one connects two networks to a device, one of ordinary skill in the art knows that two ports or two interfaces are necessary.

With respect to Issue (D), the Examiner states that the cell phone in Waller communicates with both the host computer according to claim 10 (spread spectrum 2.4 Ghz - 2.56 Ghz) and according to claim 12 (piconet) as well as over a long distance network as described in paras. 0011 and 0058.

The Examiner makes a muddle of the disclosure of Waller. In Waller, the PDA communicates through an IR port according to the IrDA protocol (para. 0060). The cell phone communicates roundabout through a telephone network and not directly over a line of sight to the ATM (para. 0075). Although Bluetooth is mentioned in para. 0011, Bluetooth is only described very generally in para. 0083 in the detailed description and not with respect to either the cell phone or the PDA and not with any of the details recited in claims 10 and 12. So the examiner's comments which assume that these units communicate using Bluetooth and using the further technology of claims 10 and 12 lack support in the cited prior art.

With respect to Issue (F), the same issue is presented. Despite the promise of paragraph 0011 under the heading "Summary of the Invention," in Waller, there is no description of a detailed embodiment to support this paragraph or to provide the details of the claimed subject matter.

With respect to Issue (G), Appellant states that the subject matter is taught by the specification, even though not stated in the same words. This is akin to disclosing something

that is all white and then claiming it as "not black" in view of a reference that discloses black. It is apparent to one of ordinary skill in the art that the present network does not require authorization for the user to access the ATM through a remotely located network host computer as is the case in ATM networks such as Waller et al. For one thing, the claims effectively distinguish from cooperation with any remotely located network host computer by virtue of the definition of a local wireless network in the claims and in the specification operating between two machines. For a second thing, the local network of the claims does not require authorization, as expressed in claim 20 and as supported by para. 0029 and the surrounding context of the specification. The Examiner is really engaging in literalism here, despite comments to the contrary.

With respect to the "third embodiment" comment, the Examiner is quoting from the Summary of the Invention in Waller. This is not a third embodiment but a third "aspect" of one embodiment said to have "seventeen aspects" in Waller. It is still maintained that the embodiments described in Waller in sufficient detail to be considered embodiments under the heading DETAILED DESCRIPTION go through the authorization procedure to the host computer (see paras. 0066 and 0076 in Waller), because that is the nature and necessity of ATM networks as described in Waller.

With respect to Issue (H), Appellants disagree that the "monitoring of maintenance information" is found or suggested by para. 0021 of Waller as stated in the Examiner's Answer. It is plainly absent.

WALLER ARGUED ONLY PROVISIONALLY - IS NOT PRIOR ART UNDER
35 U.S.C. 102(e)

Waller is not, in fact prior art under 35 U.S.C. 102(e), and if the Board were to uphold any of the Examiner's rejections, the Appellant would remove Waller as a reference by noting that the effective date of this application under 35 U.S.C. 119(e) is December 4, 2000, whereas the effective date of the Waller reference is February 9, 2001 (foreign priority not being counted for calculating the effective date of a reference under 35 U.S.C. 102(e)). MPEP 2136.03 (Aug. 2005) p. 2100-102 citing *In re Hilmer*, 359 F. 2d 859, 149 USPQ 480 (CCPA 1966).

REQUEST FOR TELEPHONIC ORAL HEARING

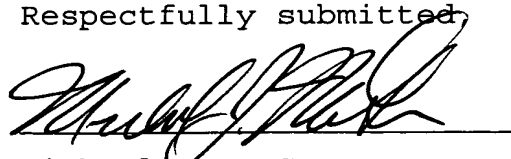
Appellants hereby request a telephonic oral hearing to conserve travel expenses and present what are deemed to be the very simple issues in this case. A separate sheet with the fee is submitted herewith.

REQUEST FOR RELIEF

Appellants respectfully request the Board to reverse the Examiner, and to grant the Appellants a patent for their invention, as expressed in claims 1-22.

Respectfully submitted,

By:



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